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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Yukio KATO et al

Art Unit: 1635

Application No.: 10/049,957

Confirmation No.: 8967

Examiner: R. Schnizer

Nationalized: 19 February 2002

Washington, D.C.

For: CHRONDROGENESIS STIMULATOR

Atty.'s Docket: KATO=21

Date: April 22, 2004

Customer Window, Mail Stop _____
THE COMMISSIONER OF PATENTS AND TRADEMARKS
Arlington, VA 22202

Sir:

Transmitted herewith is a [XX] REPLY TO RESTRICTION/ELECTION REQUIREMENT in the above-identified application.

[] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted

[] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

[XX] No additional fee is required.

The fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS	RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
TOTAL	*	MINUS	** 20	0	x 9	\$		x 18	\$
INDEP.	*	MINUS	*** 3	0	x 43	\$		x 86	\$
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ 145	\$		+ 290	\$
					ADDITIONAL FEE TOTAL			TOTAL	

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

[] First - \$ 55.00
[] Second - \$ 210.00
[] Third - \$ 475.00
[] Fourth - \$ 740.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

[] First - \$ 110.00
[] Second - \$ 420.00
[] Third - \$ 950.00
[] Fourth - \$ 1,480.00

Month After Time Period Set

[] Less fees (\$ _____) already paid for ____ month(s) extension of time on _____.

[] Please charge my Deposit Account No. 02-4035 in the amount of \$ _____.

[] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$ _____.

[] A check in the amount of \$ _____ is attached (check no.).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK

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By: _____

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: KATO=21

In re Application of:)	Art Unit: 1635 ✓
)	
Yukio KATO et al)	Examiner: R. Schnizer
)	
Appln. No.: 10/049,957)	Washington, D.C.
)	
Nationalized: 19 February 2002)	Confirmation No. 8967
)	
I.A. No.: PCT/JP00/05590)	
I.A. Date: 21 August 2000)	
)	
For: CHONDROGENESIS STIMULATOR)	April 22, 2004

REPLY TO RESTRICTION/ELECTION REQUIREMENT

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, **Mail Stop NON-FEE**
Crystal Plaza Two, Lobby, Room 1B03
Honorable Commissioner for Patents
Arlington, Virginia 22202

Sir:

Applicants are in receipt of the Office Action mailed March 23, 2004, entirely in the nature of what undersigned submits is an unauthorized hybrid restriction/election requirement, it being the position of the PTO that the claims lack unity-of-invention and therefore set forth nine (9) patentably distinct inventions, and requiring the applicants to elect only one of these nine (9) patentably distinct inventions for further prosecution on the merits.

Before addressing the requirement, applicants request the PTO to acknowledge receipt of applicants' papers filed under §119. In this regard, applicants have claimed priority, and also note that the PTO has acknowledged receipt of applicants' priority document in the form PCT/DE/EO/905 mailed May 7, 2002.

Returning to the requirement, and as applicants must make an election even though they traverse the requirement, whether or not the groups are patentably distinct from one another (regarding which applicants take no position at this time), applicants hereby respectfully and provisionally elect Group 2, the polypeptide of SEQ ID NO:4, with traverse and without prejudice.

Applicants first note that Groups 1 through 3 all appear in the same claims 1-6, 8-10 and 16, according to the Office Action. Applicants note that they are entitled to an examination of a generic claim, and that all of these claims are clearly generic. The PTO has no authority whatsoever to require an applicant to limit his or her claims, and applicants first traverse on the basis that a requirement of the present type has no legal basis.

Further in this regard, Groups 4-6 also appear in some of the same claims Groups 1-3, according to the Office Action.

Applicants further note that Groups 7 and 8 cannot be properly restricted from one another because they also appear in the same claims.

Furthermore, as the present application is the U.S. National Phase of a PCT application, the more liberal unity-of-invention practice applies, as the examiner has recognized. Under the more liberal PCT Rules, the requirement is even less appropriate. The basis expressed in the Office Action is that the nine groups are not so linked so as to form a single general inventive concept under PCT Rule 13.1, but the very existence of the generic claims (at least claims 7 and 10 for groups 1-6) shows that there is a single general inventive concept.

The reasoning of the PTO appears at the middle of page 3 of the Office Action and is based on the concept that "The technical feature linking the claimed invention is a membrane bound transferrin-like protein (MTf)." But applicants disagree.

The applicants consider that the technical feature linking the claimed invention is evidence that the applicants found for the first time that MTf proteins, including human (SEQ ID NO:2), rabbit (SEQ ID NO:4), and mouse (SEQ IS NO:15) MTf proteins, have an ability to stimulate a cartridge formation. Accordingly, the requirement should be withdrawn

at least with respect to Groups 1-3 which, in applicants' view, unquestionably belong together as part of the same invention.

The International Authorities agree with the applicants. While the applicants understand that the PTO is not bound by what the International Authorities did, such actions of the International Authorities should not be brushed aside as irrelevant in view of the principles of comity and harmonization. The same PCT Rules apply during the international phase and the U.S. national phase, so the PTO should apply the same PCT Rules 13.1 and 13.2 the same way that the International Authorities applied those rules. In this regard, in both the International Search Report and the International Preliminary Report, Groups 1-6, i.e. the invention of claims 1-10, with the exception of the invention relating to claim 16, at least are considered to meet the requirement of unity of invention.

Applicants believe that there should be no requirement in this case, and the requirement as made should be withdrawn. Unity of invention exists, and all the claims in the present application should be examined. At the very least, the requirement should be withdrawn as among Groups 1-3, and all of claim 1-6, 8-10 and 16 should be fully examined on the merits.

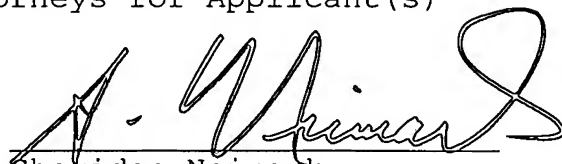
Appln. No. 10/049,957
Amd. dated April 22, 2004
Reply to Office Action of March 23, 2004

Applicants respectfully await the results of a first
examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By

A handwritten signature in black ink, appearing to read "S. Neimark", written over a horizontal line.

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